

## **REMARKS**

Applicant requests reconsideration and allowance of the subject patent application in light of the changes above and the remarks that follow.<sup>1</sup> Claims 2, 4-7 and 9-20 are pending. By this Amendment, claims 2, 4-7, 9 and 11-20 have been amended. Claims 2, 4-7, 9 and 11-17 have been amended to improve their clarity and their consistency with independent claims 18-20. Support for the subject matter added to claims 18-20 may be found in the clean copy of the specification filed on June 6, 2006 at, for example, pages 5-7.

### **Examiner Interview**

Applicant's representative greatly appreciates the opportunity provided to discuss the application in person with Examiner Obayanju and his supervisor, Examiner Harper. The following comments are provided in addition to Examiner's Interview Summary dated July 17, 2010.

During the interview, the rejection under 35 U.S.C. § 112, first paragraph was discussed. The Examiner suggested that the rejection could be overcome by changing the terms "first data storage device" and "second data storage device," respectively, to "storage support module" and "secure electronic module," which is the terminology used in the original claims. The Examiner also stated that using the term "module" rather than "device" should not raise any issues under 35 U.S.C. § 101.

As for the rejection under 35 U.S.C. § 103, claim 18 was discussed with regard to the references cited in the Office Action and the related disclosure in Applicant's specification. No particular agreement was reached with regard to the claim or the prior art. Generally, the Examiner suggested amending the claims to better distinguish over the cited references.

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<sup>1</sup> The Office Action contains statements characterizing the claims and related art. Regardless of whether any such statements are specifically addressed herein, Applicant's silence as to these characterizations should not be construed as acceptance of them.

**Rejection under 35 U.S.C. § 112, First Paragraph**

Claims 18-20 have been amended to address the Examiner's concerns stated on page 4 of the Office Action. Reconsideration and withdrawal of the rejection of claims 2, 4-7, 9 and 11-20 under 35 U.S.C. § 112, first paragraph is respectfully requested.

**Rejection under 35 U.S.C. 103**

The combination of U.S. Patent Publication No. 2004/0043792 by *Simmons* and U.K. Patent Application No. GB2355892 by *Portalier et al.* ("*Portalier*") cannot support a rejection of the pending claims under 35 U.S.C. § 103(a) because the references do not establish that all the features recited in the claims were known in the art at the time of the invention. (*See KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395 (2007); M.P.E.P. § 2143.02.)

Applicant's specification discloses an exemplary embodiment in which a handset 1 includes a secure electronic module 31 (e.g., a SIM) and a storage support module 2 (e.g., a PROM) that stores an International Mobile Equipment Identity (IMEI) 21 of the handset 1. (Specification, p. 5.) In order for the handset to join an operator's network, the secure electronic module 31 must authenticate the storage support module 2. (*Id.*) If authenticated, a secure connection 6 is established between the modules 2, 31 to transfer an encrypted copy of the IMEI 21 to the secure electronic module 31. (*Id.* at pp. 5-6.) If the secure electronic module 31 fails to properly receive the IMEI 21, the module 31 blocks the handset 1's access to the network. (*Id.* at p. 6.) On the other hand, if the secure electronic module successfully receives the IMEI 21 from the authenticated storage support module 2, the IMEI 21 is considered to be authentic and the secure electronic module enables the handset 1 to access

the network. (*Id.*) And, because the IMEI 21 is pre-authenticated by the above-described operations of the handset 1, the network allows the handset to access the network without further authentication of the IMEI 21. (*Id.*) Consequently, the network operator can be freed from the responsibility of managing keys or certificates required to authenticate handsets in the network. (*Id.*)

The independent claims broadly encompass the above-described example. For instance, claim 18 recites, “authentica[ing], by [a] second data storage device, [a] first data storage device,” “establish[ing], based on said authentication, an encrypted communication channel between the first data storage device and the second data storage device,” “transmit[ing], via the encrypted communication channel, the IMEI from the first data storage device to the second data storage device” and “enabl[ing] the handset to access the communication network based on the IMEI received by the second data storage device.” The cited references do not disclose or suggest these features of claim 18. Moreover, nothing in the cited references, when taken individually or in combination, teach or suggest the combination of features as a whole. (*See Stratoflex, Inc. v. Aeroquip Corp.*, 713 F.2d 1530, 218 USPQ 871 (Fed. Cir. 1983); *Schenck v. Nortron Corp.*, 713 F.2d 782, 218 USPQ 698 (Fed. Cir. 1983); M.P.E.P. § 2142.02.))

Neither *Simmons* nor *Portalier* disclose elements having the functionality of the claimed “storage support module” and “secure electronic module.” For example, the references say nothing with regard to, at least, “establish[ing] ... in the event the secure electronic module determines that the storage support module is authentic, a secure communication channel,” “encrypt[ing], by the storage support module, the IMEI using [a] first key,” “decrypt, by the secure electronic device, the encrypted IMEI received from the storage support module using [a] second key” and “enabl[ing], by the secure electronic

module, the handset to access the communication network in the event the secure electronic module determines that the decrypted IMEI received from the storage support module is authentic," as recited in claim 18.

Because the applied references do not disclose or suggest the above-noted features of claim 18, the references cannot support a rejection of claim 18 under § 103. Claim 18 is, therefore, allowable over *Simmons* and *Portalier*. Claims 19 and 20 recite subject matter similar to that in claim 18. Accordingly, claims 19 and 20 are also allowable over *Simmons* and *Portalier* for the same reasons as claim 18. Dependent claims 2, 4-7 and 9-17 are allowable at least due their dependence from claims 18 and 19, in addition to reciting other allowable subject matter.

### **Conclusion**

For the reasons set forth above, Applicant respectfully requests allowance of the pending claims. If additional fees are required for any reason, please charge Deposit Account No. 02-4800 the necessary amount.

Respectfully submitted,

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